

REMARKS/ARGUMENTS

Claims 1-2, 5-6, and 10 are cancelled

Claim 3, 7, and 9 are amended herein. The amendments to claims 3 and 7 are supported in the specification (p. 11, lines 22-34). Claim 9 is amended to refer back to claim 3.

Claim Rejections 35 U.S.C. § 112

Indefiniteness

Claims 6 and 10 are cancelled. Thus, Applicants believe the indefiniteness rejections with regard to these claims are now moot.

Enablement

Examiner has maintained the enablement rejection of claim 9 because of deficiencies in the Rule 132 declaration. Applicants submit herewith a substitute declaration that corrects these deficiencies. Thus, Applicants believe this rejection is overcome for the reasons outlined in the July 6, 2007 response.

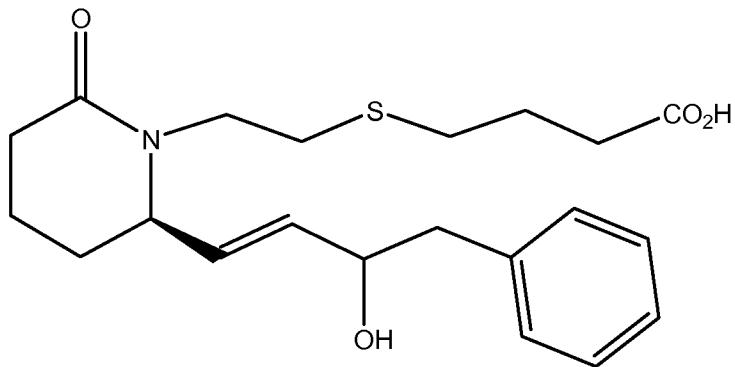
Examiner also asserts that the claims are not enable for the prevention of glaucoma in individuals that do not have elevated intraocular pressure, and suggested that applicants amend the claims to prevention of glaucoma in individuals with elevated intraocular pressure. Applicants have amended the claim as follows: “said method being effective in treating glaucoma, or preventing glaucoma in individuals with ocular hypertension, or treating intraocular hypertension.” Applicants believe this amendment overcomes the rejection.

Examiner has also entered a new ground of rejection, alleging that prodrugs of the cited compounds are not enabled. While Applicants do not admit that prodrugs are not enabled, for the sake of expediting prosecution applicants have amended the claims to substitute “ester” for “prodrug.” Examiner has

observed that the claims are enabled for making esters. Thus, the rejection is believed to be overcome.

Claim Rejections-35 U.S.C. § 102

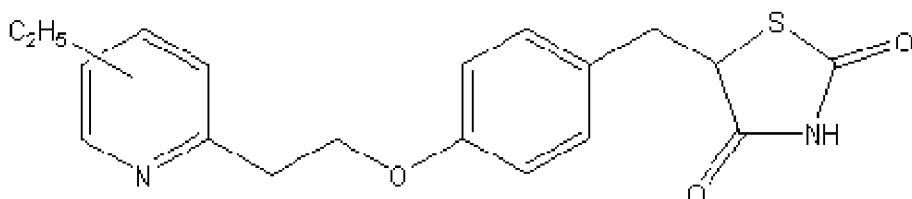
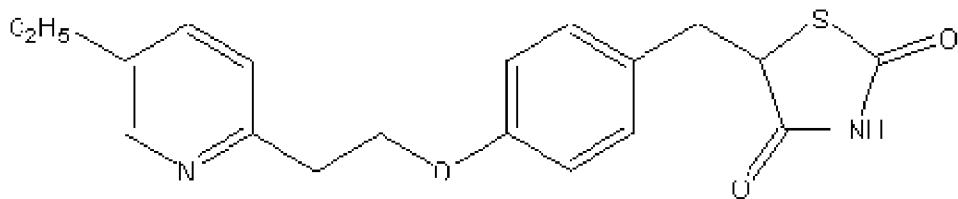
The claims were rejected as anticipated by Elworthy (US 2004/0142969). Applicants have amended the claims to include only:



and salts and esters of this compounds. Elworthy does not disclose this compound. Therefore, it is believed that this rejection is overcome.

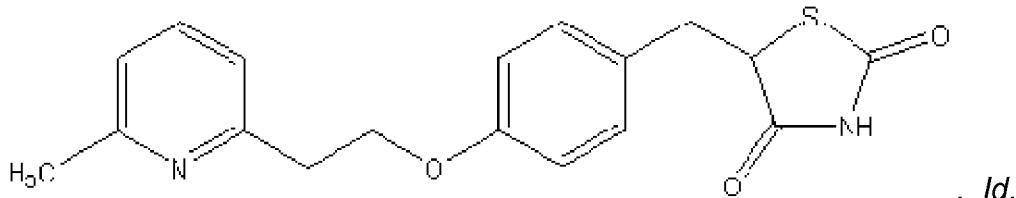
Obviousness

Recent case law has made it clear that the claims as the presently stand are not obvious. The controlling case on obviousness for claims such as those presented in the present application is *Takeda Chemical Industries, Ltd. v. Alphapharm Pty., Ltd.* 492 F.3d 1350 (Fed. Cir. 2007). In this case, the Federal Circuit upheld the District Court's finding of non-obviousness for two claims for compounds having the structures:



. *Id.* at 1353.

The closest prior art compound was:



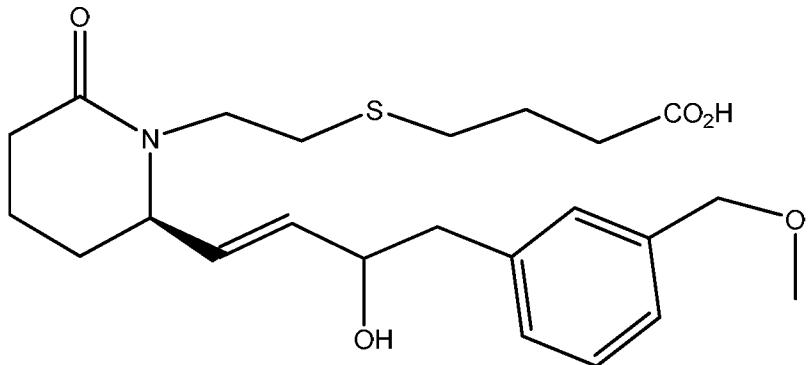
. *Id.*

Relying upon case law that included *KSR*, the court identified two requirements necessary to establish the obviousness of a claimed chemical compound:

- 1) there must be evidence that the closest prior art compound would be selected as a lead compound; and
- 2) there must be a reason based upon the cited references or other knowledge available at the time of the invention, to modify the lead compound in such a way as to obtain the claimed compound.

Id. at 1362-1363 (“The court properly concluded that Alphapharm did not make out a *prima facie* case of obviousness because Alphapharm failed to adduce evidence that compound b would have been selected as the lead compound and, even if that preliminary showing had been made, it failed to show that there existed a reason, based on what was known at the time of the invention, to perform the chemical modifications necessary to achieve the claimed compounds.”)

There is no evidence in Elworthy that the closest prior art compound cited by the Office would have been selected as a lead compound. The compound below was identified by the Office, presumably because the Office believed it was closest to the claimed compounds.



The scope of Elworthy includes millions of compounds, but Elworthy contains no data for any compounds. Thus, there is no basis for identifying which of these compounds have the most promising activity, and thus are worthy of selection as lead compounds. Therefore, the claims are not obvious because Elworthy does not reasonably lead a person of ordinary skill in the art to select the compound above as the lead compound.

Furthermore, there is nothing in Elworthy, or in the art to lead a person to modify the compound above to obtain the claimed compound. The Office might be tempted to say that the two compounds merely differ in "substitution on the core structure." But in *Takeda*, the difference between the prior art compound and the claimed compound was a methylene group on a substituent of phenyl. This is a smaller difference than methoxymethyl group here. Thus, under *Takeda* the Office must provide more than mere structural similarity to establish *prima facie* obviousness. Therefore, the claims are not obvious.

On the basis of the amendments and the arguments presented herein, Applicants believe the claims are patentable as they now stand. Therefore, Applicants respectfully request that a timely Notice of Allowance be issued in this case.

Please charge Deposit Account 01-0885 for any fees related to this response.

Respectfully submitted,

Dated: December 10, 2007

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